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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,817

08/06/2003

Jordan William Hall

CL/V-32582A

9767

31781

7590

02/23/2005

CIBA VISION CORPORATION  
PATENT DEPARTMENT  
11460 JOHNS CREEK PARKWAY  
DULUTH, GA 30097-1556

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/635,817

**Applicant(s)**

HALL ET AL.

**Examiner**

Jordan M. Schwartz

**Art Unit**

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/04, 1/04, 8/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it is too long. Specifically, the abstract cannot exceed 150 words and it therefore needs be shortened in length. Correction is required. See MPEP 37 CFR 1.72.

The specification is further objected to because on page 7, line 27 it states "Application Serial number \_\_\_\_" which needs to be filled in without creating any prohibited new matter.

### ***Information Disclosure Statement***

The information disclosure statement filed August 6, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Specifically, a copy of the cited reference "WO 00/48036" was not provided (only the first page of the reference was provided) and therefore this reference has been crossed out and has not been considered.

For applicant's further information, on the IDS received April 22, 2004, the cited reference "US2002/0759025" is not by inventor "Legerton", not dated "10/31/02, and it is believed that the cited reference number is incorrect. This reference number was changed on the IDS by the examiner to reference number "US2002/0159025" which is by inventor "Legerton", is dated 10/31/02, and therefore is believed to be the intended

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reference. If applicant intended a different reference for consideration then it is suggested that it be resubmitted on a new IDS statement.

***Claim Rejections - 35 USC § 112***

Claims 1, 3, 13, 19, 21, 26, 31, 35-36, 41 and 46 (and dependent claims 2, 4-12, 14-18, 20, 22-25, 27-30, 32-34, 37-40, 42-45, 47-48) rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1, 19, 31, 35, and 46, applicant is using the term “blending zone” which renders the claims vague and indefinite. Specifically, in independent claims 1, 19, and 35, applicant states that the “blending zone” has a surface to ensure that the peripheral zone, the blending zone, and the central optical zone are tangent to each other” but applicant is not claiming that the blending zone is providing any blending or smooth transition. However, the use of the term “blending” implies that this zone is somehow providing a smooth transition. It is therefore not clear if applicant intends smooth transition as a limitation i.e. “the blending zone has a surface to ensure that the peripheral zone, the blending zone, and the central optical zone are tangent to each other and provides a smooth transition from the central optical zone to the peripheral zone” (which is the assumed meaning for purposes of examination) or if applicant is using the term “blending zone” simply to define a zone that merely allows the central and peripheral zones to be tangent to each other (without necessarily requiring a smooth transition between) and if the latter is the intended meaning it is suggested that

applicant change "blending zone" to "intermediate zone" or some other nondescript term that does not imply a smooth transition.

In reference to claims 1, 3, 19, 21, 35, and 36, that part of the claim stating "(1) by having a lens thickness which increases progressively from the top of the lens" renders the claim vague and indefinite. Specifically, from what is described in the specification, and apparently from what is shown in the Figures, the thickness increase does not occur through the edge zone and therefore claiming "from the top of the lens", which would include the edge zone, renders the claims vague and indefinite. The assumed meaning from what is shown in the specification and Figures is, "(1) by having a lens thickness which increases progressively from the top of the peripheral zone".

In reference to claims 1, 3, 19, 21, 35, and 36, that part of the claim stating "until reaching a maximum value at a position between the optical zone and the edge zone and then decreases to the edge of the edge zone" renders the claim vague and indefinite. The "optical zone" lacks an antecedent basis and it is not clear if applicant is referring to the "central optical zone" or some other optical zone. Furthermore, the claimed "decreases to the edge of the edge zone" creates a lack of clarity because it is not clear what edge applicant is referring to i.e. the uppermost edge or the lowermost edge of this zone. For purposes of examination the assumed meaning is "until reaching a maximum value at a position between the central optical zone and the edge zone and then decreases to the upper edge of the edge zone".

In reference to claims 1, 13, 19, 26, 35, 41, that part of the claim stating "a thickness which decreases progressively from the horizontal meridian to the top or

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bottom of the contact lens” renders the claim vague and indefinite. Specifically, from what is set forth in the specification and figures, the thickness is not progressively changing through the edge zone and therefore claiming “to the top or bottom of the contact lens”, which would include the edge zone, renders the claims vague and indefinite. For purposes of examination the assumed meaning is “a thickness which decreases progressively from the horizontal meridian upward to the bottom edge of the edge zone or downward to the top edge of the edge zone along each of the vertical meridian...”.

### ***Claim Objections***

Claim 35 is objected to for the following reason. Since the intended meaning could be determined from what is set forth in the specification and Figures a 112 rejection was not made but instead this lack of clarity issue is being raised in the following claim objection. The claimed “and/or” in line 1, creates a lack of clarity and it is suggested that this part of the claim be changed to “of different cylindrical power corrections, or different multifocal powers, or both” to provide additional clarity.

Claims 2, 6-8, 15, 24, 25, 28, 39, 40, and 43 are objected to because of the following informalities. Appropriate correction is required.

With reference to claim 2, “peripheral zones” (plural) is an assumed typographical error and is assumed to mean “peripheral zone” (singular).

With reference to claims 6, 15, 24, 28, 39, and 43, “and the rest isolines” should be corrected to “and the rest of the isolines” to correct a typographical error.

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In reference to claims 7-8, 25, and 40, "the the" needs to be corrected (and in some cases in two places within each of these claims).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 13-14, 16, 19-20, 26-27, 29, 31-32, 35, 41-42, 44, and 46-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobstein patent number 4,618,229.

Jacobstein reads on these claims by disclosing the limitations therein including the following: a contact lens comprising a posterior and anterior surface (abstract, Figures 4 and 6); the anterior surface including a central optical zone (Figure 6, optical zone "48"); a blending zone extending from the central optical zone (Figure 6, "38" and "42" combined); a peripheral zone surrounding the blending zone (Figure 6, that portion of the lens surrounding zones "48", "38" and "42" but excluding the edge zone); an edge zone circumscribing an tangent to the peripheral zone (Figure 6, "20", column 5, line 41). The lens will inherently have a vertical and horizontal meridian since these are defined in the specification in terms of imaginary lines on the contact lens (page 6 of the specification). Jacobstein further discloses the blending zone has a surface to ensure that the peripheral zone, the blending zone, and the central optical zone are tangent to each other and provides a smooth transition from the central optical zone to the

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peripheral zone (the assumed meaning, column 4, line 30 re surfaces "38" and "42" as add surfaces therefore providing a smooth transition, and Figures 4 and 7a which shows a smooth transition between these portions of the lens); the peripheral zone having a thickness profile characterized by a mirror symmetry with respect to a plane cutting through the vertical meridian (Figures 4 and 6); a substantially constant thickness in a region around the horizontal meridian (Figures 4 and 7a); and a thickness which decreases progressively from the horizontal meridian upward to the bottom edge of the edge zone (Figures 4 and 7a which disclose the thickness substantially constant at the lens center and progressively decreasing upward). The area of the peripheral zone is inherently equal to or larger than that of the central optical zone, this being reasonably based upon what is disclosed in Figure 6). The lens thickness will inherently remain substantially constant along a series of isolines running from side to side of the lens, this being reasonably based upon the side to side symmetry of the lens (Figure 6). Jacobstein further discloses the thickness in the peripheral zone decreasing significantly when approaching the top of the lens (Figure 4); that the lens can be manufactured on a numerically controlled lathe (column 3, line 30); and the lens as a bifocal lens (column 3, line 30). Since different bifocal lenses will inherently have different optical powers, depending upon the lens prescription of the user, then a number of such lenses can inherently be considered as a "series of contact lenses having a series of different multifocal powers". The blending zone can inherently be considered as comprising a series of optical portions in contact with each other and therefore can inherently be considered as comprising a series of "surface patches".



***Double Patenting***

Claims 1, 3-4, 7-8, 10-13, 18-22, 25-26, 30-32, 35-37, 40-41, and 45-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of copending Application No. 10/762,039 (publication number 2004/0156013 referred to below as "Lindacher et al'013). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Lindacher et al'013 discloses the limitations therein including the following: a contact lens having a central optical zone, peripheral zone, blending zone and edge zone as claimed (claim 18); the blending zone ensuring that the peripheral zone, blending zone and central optical zone are tangent to each other (claim 18); the peripheral zone having a thickness profile characterized by "1" or "2" of applicant's claim 1 (claim 18); the thickness profile having a mirror symmetry with respect to a plane cutting through the vertical meridian (claim 18); the peripheral zone comprising a ridge feature as claimed (claims 16 and 18); the peripheral zone comprising a ramped ridge zone as claimed (claims 17 and 18); the peripheral zone, blending zone, or anterior surface the lens has a continuity in first or second derivative, specifically defined by a spline based function (claim 3 and 18); the lens manufactured by a numerically controlled lathe (claims 18 and 43). Lindacher et al'013 does not specifically disclose the contact lens as a bifocal contact lens or a series of such lenses. The examiner takes

Judicial Notice that it is well known in the art of contact lenses for contact lenses to be bifocal lenses to provide the required prescriptive correction of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the contact lens of Lindacher et al'013 to be a bifocal lens since it is well known in the art of contact lenses for such lenses to be bifocal to provide the required prescriptive correction of the user. Two or more of such lenses would inherently be a series of such lenses.

Claims 1, 3-4, 7-8, 12-13, 19-22, 25-26, 32, 35-37 and 40-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-71 of copending Application No. 10/822,564 (publication number 2004/0207807 referred to below as "Lindacher'807"). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Lindacher'807 discloses the limitations therein including the following: a contact lens having a central optical zone, peripheral zone, blending zone and edge zone as claimed (claim 17); the blending zone ensuring that the peripheral zone, blending zone and central optical zone are tangent to each other (claim 17); the peripheral zone having a thickness profile characterized by "1" or "2" of applicant's claim 1 (claim 17); the thickness profile having a mirror symmetry with respect to a plane cutting through the vertical meridian (claim 17); the peripheral zone comprising a ridge feature as

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claimed (claims 15 and 17); the peripheral zone comprising a ramped ridge zone as claimed (claims 16 and 17); the lens manufactured by a numerically controlled lathe (claims 47, 44, 17). Lindacher'807 does not specifically disclose the contact lens as a bifocal contact lens or a series of such lenses. The examiner takes Judicial Notice that it is well known in the art of contact lenses for contact lenses to be bifocal lenses to provide the required prescriptive correction of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the contact lens of Lindacher'807 to be a bifocal lens since it is well known in the art of contact lenses for such lenses to be bifocal to provide the required prescriptive correction of the user. Two or more of such lenses would inherently be a series of such lenses.

Claims 1, 3-4, 7-8, 12-13, 19-22, 25-26, 32, 35-37 and 40-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/766,194 (publication number 2004/0257526 referred to below as "Lindacher'526). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Lindacher'526 discloses the limitations therein including the following: a contact lens having a central optical zone, peripheral zone, blending zone and edge zone as claimed (claim 13); the blending zone ensuring that the peripheral zone, blending zone

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and central optical zone are tangent to each other (claim 13); the peripheral zone having a thickness profile characterized by "1" or "2" of applicant's claim 1 (claim 13); the thickness profile having a mirror symmetry with respect to a plane cutting through the vertical meridian (claim 13); the peripheral zone comprising a ridge feature as claimed (claims 11 and 13); the peripheral zone comprising a ramped ridge zone as claimed (claims 12 and 13); the lens manufactured by a numerically controlled lathe (claims 13 and 31). Lindacher'526 does not specifically disclose the contact lens as a bifocal contact lens or a series of such lenses. The examiner takes Judicial Notice that it is well known in the art of contact lenses for contact lenses to be bifocal lenses to provide the required prescriptive correction of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the contact lens of Lindacher'526 to be a bifocal lens since it is well known in the art of contact lenses for such lenses to be bifocal to provide the required prescriptive correction of the user. Two or more of such lenses would inherently be a series of such lenses.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

#### ***Allowable Subject Matter***

Claims 3-12, 15, 17-18, 21-25, 28, 30, 33-34, 36-40, 43, 45, 48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims (and overcoming the double patenting rejections and claim objections above).

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 3-12, 21-25, and 36-40, none of the prior art either alone or in combination disclose or teach of the claimed contact lens, method of producing a contact lens, or series of contact lenses, specifically including, as the distinguishing feature in combination with the other limitations, the claimed thickness

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profile progressively increasing and decreasing as claimed. Specifically, with reference to claims 15, 28 and 43, none of the prior art either alone or in combination disclose or teach of the claimed contact lens, method of producing a contact lens, or series of contact lenses, specifically including, as the distinguishing feature in combination with the other limitations, the claimed isolines as arcs above and below different from each other and mimicking arcs of the eyelid as claimed. Specifically, with reference to claims 17 and 33, none of the prior art either alone or in combination disclose or teach of the claimed contact lens or method of producing a contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed edge zone as circular and in combination with the posterior surface, providing a substantially uniform thickness around the edge of the lens. Specifically, with reference to claims 18, 34 and 48 none of the prior art either alone or in combination disclose or teach of the claimed contact lens, method of producing a contact lens, or series of contact lenses, specifically including, as the distinguishing feature in combination with the other limitations, the claimed anterior surface as continuous in first derivative or second derivative or both from center to edge. Specifically, with reference to claims 30 and 45, none of the prior art either alone or in combination disclose or teach of the claimed method of producing a contact lens or series of contact lenses, specifically including, as the distinguishing feature in combination with the other limitations, the claimed entire peripheral zone having a continuity in first derivative, second derivative or both.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571)

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272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
February 18, 2005